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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/025,649   | 12/19/2001  | Linda G. Butler      | BELL-0160/01307     | 8250             |
| 23377  | 7590        | 02/27/2006           | EXAMINER            |                  |
| WOODCOCK WASHBURN LLP<br>ONE LIBERTY PLACE, 46TH FLOOR<br>1650 MARKET STREET<br>PHILADELPHIA, PA 19103 |             |                      | JEANTY, ROMAIN      |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3623                |                  |

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                           |                  |
|------------------------------|---------------------------|------------------|
| <b>Office Action Summary</b> | Application No.           | Applicant(s)     |
|                              | 10/025,649                | BULTER ET AL.    |
|                              | Examiner<br>Romain Jeanty | Art Unit<br>3623 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 19 December 2001.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-27 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-8,11-13,15-18,23 and 25-27 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) 9-12,14,19-22 and 24 are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)              |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____.  |

## **DETAILED ACTION**

1. This Non-Final Office Action is in response to the communication received December 19, 2001. Claims 1-27 are pending in the application for examination.

### **Claim Rejections - 35 USC § 112**

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7, 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 1 recites the limitation "defining additional requirements". It is unclear as what applicants mean by additional requirements, and this limitation renders the claim vague and indefinite.

Further, claim 1 also recites the limitation "... must follow the framework". This limitation is not clear and it renders the claim vague and indefinite. Appropriate action is required.

Claim 7 recites the limitation "... the organization 10". It is not clear as to what organization 10 applicants are referring. There is no antecedent basis for organization 10 in the claim.

Claim 13 recites the limitation "... the entity 12". It is not clear as to what entity 12 applicants are referring. There is no antecedent basis for organization 10 in the claim.

Claim 12 recites the limitation "the model 26" in line 2. It is not clear as to what model 12 applicants are referring. There is insufficient antecedent basis for this limitation in the claim.

### **Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claim 18 is rejected under 35 U.S.C. 102(e) as being anticipated over Bond (U.S. Patent No. 6,738,736).

As per claim 18, Bond discloses initiating a business idea regarding acquiring an IT product, the business idea being based on factors including available technology and a rough feasibility estimate of cost and benefit (col. 2, lines 25-33), developing the rough estimate into a detailed estimate including a cost of and a benefit of acquiring the IT product (col. 2, lines 2-36), the detailed estimate being employed to decide if and how to acquire the IT product and coinciding with composing a proposal including a funding request for funding from the organization for acquiring the IT product (col. 8, lines 27-36), submitting the proposal to a centralized prioritizing agent for the organization, the centralized prioritizing agent performing a prioritization process including examining all proposals within the organization and determining whether to approve each proposal based on factors including need, cost, available funding, and

priority (col. 8, lines 37-49; col. 9, lines 16-25), upon receiving approval from the centralized prioritizing agent, developing requirements and planning for the IT product to be acquired by specifying the IT product in a more technologically specific manner, and receiving delivery of the IT product (col. 54-63).

### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8, 13, 15-17, 23, 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bond (U.S. Patent No. 6,738,736) in view of Bernard et al (U.S. Patent No. 6,738,746).

As per claims 1, 3-4 and 7, Bond discloses a first policy that each entity of the organization must follow the framework, a second policy defining a business process that each entity must follow when acquiring an IT product (i.e. more than one policies for the capacity planning) col. 14, lines 5-14), a third policy defining a set of tools for being employed to implement the business process of the second policy (col. 5, lines 15-20). Bond does not explicitly disclose a fourth policy defining additional requirements specific to one or more of the entities within the organization, where the additional requirements for each entity are defined by such entity. Bernard in the same field of endeavor, discloses the concept of defining additional requirements by an entity (col. 26, line30 through col. 28 line 67). It would have been obvious to

a person of ordinary skill in the art to modify the disclosure of Bond to incorporate the teaching of Bernard et al in order to provide an optimized solution for outsourcing procurements of goods and services.

As per claim 2, Bond further discloses the framework of claim 1 further comprising a policy that different entities within the organization must work together to acquire the IT product when such IT product is substantially common to such different entities (col. 14, lines 5-14).

As per claim 5, Bond further discloses the framework of claim 4 wherein the third policy is embodied as a central repository accessible by all of the entities within the organization (i.e., providing clients access to a database) (col. 9, lines 28-31).

As per claim 6, the combination of Bond and Bernard et al does not explicitly disclose wherein the repository is a database accessible by way of an electronic web page. Accessing a database by way of an electronic web page is notoriously old and well known in the database art. It would have been obvious to a person of ordinary skill in the art to include this well-known teaching into the disclosures of Bond and Bernard with the motivation for searching for and returning data.

As per claim 8, Bond further discloses the framework of claim 1 wherein the business process of the second policy comprises initiating a business idea regarding acquiring an IT product, the business idea being based on factors including available technology and a rough feasibility estimate of cost and benefit (col. 2, lines 25-33), developing the rough estimate into a detailed estimate including a cost of and a benefit of acquiring the IT product (col. 2, lines 2-36), the detailed estimate being employed to decide if and how to acquire the IT product and

coinciding with composing a proposal including a funding request for funding from the organization for acquiring the IT product (col. 8, lines 27-36), submitting the proposal to a centralized prioritizing agent for the organization, the centralized prioritizing agent performing a prioritization process including examining all proposals within the organization and determining whether to approve each proposal based on factors including need, cost, available funding, and priority (col. 8, lines 37-49; col. 9, lines 16-25), upon receiving approval from the centralized prioritizing agent, developing requirements and planning for the IT product to be acquired by specifying the IT product in a more technologically specific manner, and receiving delivery of the IT product (col. 54-63).

As per claims 13, 15-17, 23, 25-27, the claimed features are standard practice of IT product development and evaluation. It would have been obvious to a person of ordinary skill in the art at the time of the applicants' invention to include such features into Bond and Bernard in order to build, testing, deploy a capacity modeling and planning function for an IT organization.

### **Allowable Subject Matter**

6. Claims 9-12, 14, 19-22, and 24 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### **Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

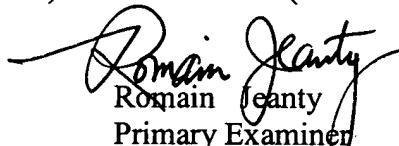
a. Ruffin et al (U.S. Patent No. 6,526,387) discloses a method for evaluating particular aspects of a business enterprise and business-related requirements of the enterprise which may, for example, include information technology (IT) requirements, and efficiently developing a business solution deliverables such as an IT system proposal based upon an articulated set of those requirements.

b. Ubnderwood (U.S. Patent No. 6,718,535) discloses software framework designs and more particularly to an activity framework that allows efficient reuse of sub-activities.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (571) 272-6732. The examiner can normally be reached on Mon-Thurs 7:30AM - 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Romain Jeanty  
Primary Examiner  
Art Unit 3623

1-9-06